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10/056,152	01/24/2002	Takahiro Mori	02028/HG	2277

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EXAMINER	
GILLIAM, BARBARA LEE	
ART UNIT	PAPER NUMBER
1752	3

DATE MAILED: 07/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Applicati n No.	Applicant(s)	
	10/056,152	TAKAHIRO MORI	
	Examiner	Art Unit	
	Barbara Gilliam	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the corresp ndence address --

Peri d for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 January 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 January 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claims

2. Claims 1-14 are present.

3. The term "lyophilic" of Claim 1 has been interpreted in light of the specification. At page 13, line 17, "lyophilic" is equated with ink affinity. MPEP 2173.05(a).

4. The Examiner has interpreted the required sequence of layers in Claim 7 to be layer C, layer B, layer A wherein layer C is adjacent to the substrate.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. US 6,596,462 B2 in view of Teng (US 6,482,571 B1).

a. In US 6,596,462 B2, Mori claims a printing element comprising a substrate and a first component layer containing a first material and an oligosaccharide as a second material (claim 1). The first component layer containing a water soluble material as the first material (claim 13) meets the present limitations for the layer A. A second hydrophilic component layer is provided between the substrate and the first component layer (claim 3) which is a porous layer (claim 4) and contains a light-heat conversion material (claim 5). The second component layer contains a water-soluble polysaccharide (claim 6) and meets the present limitations for the layer B. A third component layer is present between the substrate and the second component layer (claim 8). The third component layer meets the present limitations for the layer C. The printing plate is imagewise exposed and developed using an aqueous solution (claim 18) on a printing machine (claim 19). The aqueous solution of Mori does not meet the present limitations for the emulsion ink.

b. It would have been obvious to use an emulsion of ink and fountain solution to develop and print the exposed plate of Mori based on the teachings of Teng. In US 6,482,571 B1, Teng teaches on-press development of thermosensitive lithographic plates using ink ad/or fountain solution (abstract). Ink and fountain solution are emulsified on the ink rollers before transferred to the plate (column 8, lines 57-67). Optionally an aqueous solution can be applied to the exposed plate before development with ink and/or fountain solution (column 9, lines 60-64). A single-fluid ink can be

used without the fountain solution (column 9, lines 47-59). The plate can be exposed before placement on a printing press cylinder or after placement on the printing press (column 9, lines 33-37).

c. Therefore it would have been obvious to one of ordinary skill in the art to imagewise expose a printing plate precursor with laser light, remove the unexposed area of the printing plate using an emulsion of ink and fountain solution on-press wherein the planographic printing plate precursor comprises a substrate, a first component layer containing an oligosaccharide, a second porous hydrophilic component layer provided between the substrate and the first component layer and a third component layer present between the substrate and the second component layer based on the teachings of Mori without any other processing steps based on the teachings of Teng (column 1, lines 42-47).

d. Teng's teaching to optionally supply an aqueous solution (including water and fountain solution) to the exposed plate surface to dampen without development, before on-press development with ink and/or fountain solution (column 9, lines 60-64), meets the present limitations for supplying water to the surface of the plate prior to supplying emulsion ink. It would have been obvious to use any method conventional in the art to supply the aqueous solution including spraying devices present on conventional wet press printing machines. Teng does not specifically teach the amount of aqueous solution used, however it is the Examiner's position the amount used is expected to satisfy the inequality of present claim 12. The inequality of present claim 12 covers a broad range with respect to the amount of aqueous solution. The Examiner

asserts the amount sufficient to dampen the surface of the exposed plate is expected to satisfy the inequality.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1-3, 5-6, 9, 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vander Aa.

a. In US 2002/0072013 A1, Vander Aa teach a method of making a lithographic printing master by providing an imaging material which comprises a lithographic base having a hydrophilic surface and a non-ablative image-recording layer which is removable in a single-fluid ink or can be rendered removable in a single-fluid ink by exposure to heat or light. The image recording layer is image-wise exposed to heat or light and processed by supplying a single-fluid ink to the image recording layer which is an emulsion of an ink phase and a non-aqueous polar phase (abstract & claims 1-2, 7). According to Vander Aa, non-aqueous means that he polar phase comprises at least 50%, more preferably at least 70 % and even more preferably at least 90 % of a non-aqueous, polar liquid (page 2, paragraph [0011]). Up to about 4 or 5 % by weight of water may be included in the polyol (polar) phase mixture to aid in dissolving or homogenizing the ingredients of the polyol phase (page 9, paragraph [0064]). The

single-fluid ink comprising an ink phase and a polyol phase comprising water meets the present limitations for the emulsion ink. The non-ablative image recording layer comprises hydrophobic thermoplastic polymer particles (claim 3) preferably dispersed in a hydrophilic binder (page 3, paragraph [0029]). Suitable hydrophilic binders include polysaccharides such as dextran, pullulan, cellulose, Arabic gum and alginic acid (page 4, paragraph [0031]). The image recording layer meets the present limitations for the image forming layer A. The hydrophilic base may be a film support to which an adhesion improving layer comprising a hydrophilic binder and colloidal silica has been provided (page 3, paragraph [0023] – [0025]). The light absorbing compound may be present in another layer close to the recording layer (page 5, paragraph [0038]). It is within the teachings of Vander Aa to incorporate the light absorbing compound in the adhesion improving layer. This adhesion improving layer meets the present limitations for hydrophilic layer B. The imaging layer can be applied on the lithographic base before or after mounting the base on the print cylinder (page 5, paragraph [0037]). In the Examples, imaging material 1 was exposed using a 830nm platesetter and subsequently mounted on a print cylinder where the single-fluid ink was supplied using an integrated ink supply/dampening system (page 12, paragraphs [0101] - [0104]). The Examiner asserts this teaching would suggest the single-fluid ink is supplied throughout printing.

b. Therefore it would have been obvious to one of ordinary skill in the art to make a lithographic printing master by providing a non-ablative image-recording material on a lithographic base provided with a hydrophilic adhesion improving layer, image-wise exposing the recording material to heat or light and processing the exposed

material by supplying a single-fluid ink to the image recording layer which is an emulsion of an ink phase and a non-aqueous polar phase wherein the recording material comprises hydrophobic thermoplastic polymer particles dispersed in a hydrophilic binder such as dextran, and pullulan with reasonable expectation of obtaining a lithographic printing plate with simplified on-press processing according to the teachings of Vander Aa (page 2, paragraph [0011]).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. In US 6,596,464 B2, Van Damme et al. teach a lithographic printing method using single-fluid ink.

b. In US 6,399;276 B1, Van Damme et al. teach processless printing plate with cover layer containing compounds with cationic groups.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara Gilliam whose telephone number is 703-305-1330. The examiner can normally be reached on Monday through Friday, 8:00 AM - 6:00 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

872-9310 for regular communications and 703-872-9311 for After Final communications.

b. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Barbara Gilliam

Barbara Gilliam
Examiner
Art Unit 1752

bg
July 23, 2003